

REMARKS

Claims 1-52, all the claims pending in the application, stand rejected on prior art grounds. Claims 1, 3, 10, 11, 14, 18, 20, 27, 28, 31, 35, 37, 44, 45, 48, and 52 are amended herein. Applicants respectfully traverse these rejections based on the following discussion.

I. The Prior Art Rejections

Claims 1-52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Souder et al. (U.S. Patent No. 6,889,231), hereinafter referred to as “Souder” in view of Good et al. (U.S. Publication No. 2003/0088589), hereinafter referred to as “Good”. Applicants respectfully traverse these rejections based on the following discussion.

Submitted herewith is a Declaration under 37 CFR §1.131 swearing behind portions of the Souder reference. The Rule 131 Declaration removes portions of the Souder reference from consideration. MPEP §715.09 provides that a Rule 131 Declaration is considered timely submitted if it is submitted prior to a final rejection. Therefore, the attached Rule 131 Declaration swearing behind portions of the Souder reference is seasonably presented.

The Applicants have a filing date of August 21, 2003. Souder has a filing date of December 2, 2002. However, Souder claims priority to U.S. Provisional Application No. 60/400,532, which was filed on August 1, 2002 and U.S. Provisional Application No. 60/410,883, which was filed on September 12, 2002. Conventionally, a Rule 131 Declaration is not appropriate where, according to MPEP §715(II)(A), “the reference publication data is more than 1 year prior to Applicants’ or patent owner’s effective filing date.” However, upon review of U.S. Provisional Application No. 60/400,532, it is evident that significant portions of the

Souder reference, which are being used in the Office Action to reject Applicants' claimed invention, are not fully supported in that particular provisional application. Accordingly, the Applicants contend that U.S. Provisional Application No. 60/400,532 should only constitute an effective prior art reference (and its August 1, 2002 filing date) for only those portions that are carried through in the Souder reference (U.S. Patent No. 6,889,231).

MPEP §706.02(a)(V)(D) states, "[i]f the application properly claims benefit under 35 USC 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 USC 112 by the provisional application." Moreover, MPEP §715.02(I) generally allows one to overcome a 35 USC 103 rejection based on a combination of references, as in the present situation, by showing completion of the invention by the Applicant(s) prior to the effective date of any of the references.

Furthermore, MPEP §2136.02 generally provides that when a U.S. patent application publication is used to reject claims, "the disclosure relied on in the rejection must be present in the issued patent or application publication." Accordingly, it is the earliest effective U.S. filing date (August 1, 2002) of the Souder reference (i.e., U.S. Provisional Application No. 60/400,532) that is being relied upon that is "the critical reference date and subject matter not included in the patent or application publication itself can only be used when that subject matter becomes public. Portions of the patent application which were canceled are not part of the patent or application publication and thus cannot be relied on in a rejection over the issued patent or application publication. Additionally, "[s]hould it be established that the portion of the patent, or patent application publication, disclosure relied on as the reference was introduced into the

patent application...was new matter, the date to be overcome by the affidavit or declaration is the date of the [introduction of new matter].” See generally, MPEP §715(III)(A). Therefore, because significant portions of the Souder reference were not fully presented in Provisional Application No. 60/400,532, the effective date of only a portion of the Souder reference should properly be September 13, 2002.

Upon comparison of Souder with U.S. Provisional Application No. 60/400,532, it appears that in Souder, the language on column 43, line 36 through column 50, line 67, as well as FIGS. 24-25 constitute new matter not taught in U.S. Provisional Application No. 60/400,532.

Furthermore, the Office Action specifically refers to specific language in Souder contained on these pages, column 43, line 36 through column 45, line 42, as a basis for rejecting the Applicants’ claimed invention. Accordingly, based on the accompanying Rule 131 Declaration, the Applicants swear behind these portions of the Souder reference, thereby overcoming the rejection.

Specifically, page 7 of the Office Action refers to column 43, line 36 through column 45, line 42 of Souder in view of Good as a basis for rejecting the Applicants’ dependent claim 14 (and claims 31 and 48 implicitly) (i.e., teaching the apply service utilizes an in-memory index when a system crash occurs and a recovery process is initiated by the distributed computing system). Such features are now generally incorporated in the Applicants’ amended independent claims 1, 18, and 35, respectively.

Thus, it is clearly evident that portions of the rejections (rejections for at least claims 14, 18, and 35) in the Office Action are based on those teachings in Souder, which has an effective date of September 13, 2002, and which Provisional Application No. 60/400,532 cannot be

properly used as a basis for establishing an earlier priority date for these teachings. Accordingly, the Applicants' accompanying Rule 131 Declaration effectively swears behind portions of the Souder reference, thereby overcoming the rejection of claims 1, 3, 5-7, 10, 12-14, 17, and 19-20.

Souder teaches techniques for sharing information in a wide variety of contexts that allows both an explicit capture process and an implicit capture process to add information items to a staging area. An information sharing system supports both implicit and explicit consumption of information items that are stored in the staging area. A rules engine allows users to create and register rules that customize the behavior of the capture processes, the consuming processes, and propagation processes that propagate information from the staging areas to designated destinations. Exactly-once handling of sequence of items is achieved for items maintained in volatile memory. DDL operations are recorded, and operations are asynchronously performed based on the previously-performed DDL operations.

Good teaches a directory server including a supplier server, a consumer server in communication with the supplier server, a plurality of pluggable services that manage replication of data contained within the directory server from the supplier server to the consumer server, and a change sequence number used to determine ordering of operations performed on the consumer server. Replication of data is managed using the change sequence number.

However, the claimed invention, as provided in amended independent claims 1, 18, 35, and 52 include features, which are patentably distinguishable from the prior art references of record. Specifically, claims 1, 18, and 35 recite, in part, “...[means for] using an apply service at said target site to embed and analyze said tracking information during a crash recovery sequence, wherein said apply service utilizes an in-memory index when a system crash occurs and a

recovery process is initiated by said distributed computing [data replication] system.”

Furthermore, claim 35 recites, in part, “...wherein said target site comprises an apply service operable to embed and analyze said tracking information during a crash recovery sequence, and wherein said apply service utilizes an in-memory index when a system crash occurs and a recovery process is initiated by said data replication system....” These features are simply not taught or suggested in the prior art references of record. Furthermore, Souder does not teach applying both the tags and the deltas atomically. Rather, Souder simply teaches that the information system routes specified information to specified destinations, but this does not address atomic updates, as provided by the Applicants’ claimed invention. The information being routed in Souder is a stream of replication deltas, so there is no way in which all of the information can be transmitted atomically in Souder, which is contrary to the Applicants’ claimed invention.

Moreover, amended dependent claims 3, 20, and 37 generally provide, “wherein said capture service is adapted to prevent resending of an already sent delta production/consumption value from a source site to said target site.” Additionally, amended dependent claims 14 and 31 generally provide, “wherein communication between said capture service and said apply service occurs over an unreliable user datagram protocol (UDP) communication channel.” Similarly, amended dependent claim 48 generally provides, “wherein said communication channel comprises an unreliable user datagram protocol (UDP) communication channel.” These features further distinguish the Applicants’ claimed invention from the prior art references of record.

Insofar as references may be combined to teach a particular invention, and the proposed combination of Souder and Good with one another, case law establishes that, before any prior-art

references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined.

For example, in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated:

"[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings."

Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for a part of another reference in order to try to meet, but failing nonetheless, the Applicants' novel claimed invention. Furthermore, the claimed invention, as amended, meets the above-cited tests for obviousness by including embodiments such as "[means for] using an apply service at said target site to embed and analyze said tracking information during a crash recovery sequence, wherein said apply service utilizes an in-memory index when a system crash occurs and a recovery process is initiated by said distributed computing system" as recited in amended claims 1, 18, and 52 and "wherein said target site comprises an apply service operable to embed and analyze said tracking information during a crash recovery sequence, and wherein said apply service utilizes an in-memory index when a system crash occurs and a recovery process is initiated by said distributed computing system" as recited in claim 35. As such, all of the claims

of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Souder fail to disclose all of the elements of the claims of the present invention, particularly, the apply service utilizing an in-memory index when a system crash occurs and a recovery process initiated by the distributed computing system as discussed above, but also, if combined with Good, fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Souder, alone or in combination Good teaches a system and method containing all of the limitations of the claimed invention. Consequently, there is

absent the “suggestion” or “objective teaching” that would have to be made before there could be established the legally requisite “prima facie case of obviousness.”

In view of the foregoing, the Applicant respectfully submits that the collective cited prior art do not teach or suggest the features defined by amended independent claims 1, 18, 35, and 52 and as such, claims 1, 18, 35, and 52 are patentable over Souder alone or in combination with Good. Further, dependent claims 2-17, 19-34, and 36-51 are similarly patentable over Souder alone or in combination with Good, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Moreover, the Applicant notes that all claims are properly supported in the specification and accompanying drawings. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

IV. Formal Matters and Conclusion

With respect to the objections/rejections to the claims, the claims have been amended, above, to overcome these objections/rejections. Additionally, the Rule 131 Declaration that accompanies this Amendment swears behind portions of the Souder reference. Again, the Applicants have a filing date of August 21, 2003, and has documented proof to establish that the claimed invention was conceived and reduced to practice at least one year prior to August 21, 2003. The Souder patent application was filed on December 2, 2002 and has a priority date of August 1, 2002 based on U.S. Provisional Application No. 60/400,532 and a priority date of

September 13, 2002 based on U.S. Provisional Application No. 60/410,883. However, a review of U.S. Provisional Application No. 60/400,532 filed on August 1, 2002 reveals that the provisional application does not teach all of the features defined in Applicants' amended independent claims 1, 18, 35, and 52, and as such, the right of priority should not extend beyond the September 13, 2002 (at the very least) date relating to the features provided in these claims. Accordingly, the Applicants should be entitled to swear behind the Souder reference as of the September 13, 2002 date, which is within the one-year provision (i.e., within one-year from the Applicants' filing date) entitled by 37 CFR §1.131 for submitting such an affidavit. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1-52, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,



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